PATENT

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REPLY BRIEF UNDER 37 C.F.R. § 41.41

Application Serial No.: 10/576,048

Filed/371(c) date: August 7, 2006

Applicants/Appellants: Koichi SHIMAMURA et al.

Title: SERVER APPARATUS AND CLIENT APPARATUS IN PRESENCE DISPLAY SYSTEM

Appeal from a decision of the Primary Examiner dated July 31, 2009

Reply to the Examiner's Answer dated February 18, 2010

Atty. Docket: VPM-01601

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SUBMISSION OF REPLY BRIEF UNDER 37 C.F.R. § 41.41

This reply brief is being submitted under 37 C.F.R. § 41.41 in reply to the Examiner's Answer dated February 18, 2010. Appellants appeal from the decision of the Primary Examiner dated July 31, 2009, and incorporate by reference herein all necessary portions and arguments set forth in Appellants' Appeal Brief filed on January 12, 2010.

STATUS OF CLAIMS

This is an appeal from a decision of the Primary Examiner in the Office Action dated July 31, 2009, rejecting claims 2-50 in the above identified patent application; and claims 2-50 are on appeal. Claim 1 has been previously cancelled. Claims 2-50 stand rejected under 35 U.S.C. 103(a). No claim has been allowed or indicated to contain allowable subject matter. Appellants appeal the above-noted rejections. The Office Action of July 31, 2009, indicated that prosecution of the application was reopened by the Supervisory Patent Examiner (SPE) in view of Appellants' Appeal Brief previously filed on April 27, 2009. In accordance with option (2) identified on page 2 of the Office Action, in response to the Office Action, Appellants initiated this new appeal by filing a Notice of Appeal on December 29, 2009. Appellants filed an Appeal Brief on January 12, 2010.

GROUNDS OF REJECTION UNDER APPEAL

I. Claims 2-7, 9-14, 16, 18, 19, 21, 23, 24, 27-30 and 32-50 stand rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1,176,840 to De Vries (hereinafter "De Vries") in view of U.S. Patent App. Pub. No. 2004/0170263 to Michael, et al. (hereinafter "Michael").

II. Claims 8, 17, 22, 25 and 26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over De Vries in view of Michael and further in view of U.S. Patent No. 6,658,095 to Yoakum, et al. (hereinafter "Yoakum").

III. Claims 15, 20 and 31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over De Vries in view of Michael and further in view of U.S. Patent App. Pub. No. 2004/0162882 to Mora (hereinafter "Mora").

ARGUMENTS IN REPLY TO EXAMINER'S ANSWER

Appellants maintain that the Examiner has failed to establish a prima-facie case of obviousness under 35 U.S.C. §103(a) of claims 2-50 as being unpatentable over the cited prior art references, either individually or in any combination.

Appellants maintain that the rejection of claims 2-7, 9-14, 16, 18, 19, 21, 23, 24, 27-30 and 32-50 under 35 U.S.C. 103(a) as being unpatentable over De Vries and further in view of U.S. Patent App. Pub. No. 2004/0170263 to Michael, et al. (hereinafter "Michael") has been traversed, and it is respectfully requested that the rejection be reversed by the Board.

De Vries discloses place-specific buddy list services including an information service which provides search and notifications to inform when certain people (e.g., friends, family, business contacts, etc.) are nearby so as to facilitate communications with those people. As is noted on page 5 of the Office Action (and in the Examiner's Answer), De Vries does not explicitly disclose means for creating a list of other users that are watching the state of the user and transmitting the list of the user in accordance with a request from the user. The Office Action (and Examiner's Answer) then cites to Michael as disclosing these features in connection with the rejection under 35 U.S.C. 103(a).

Michael discloses a telecommunications system that includes a telephone routing system and a presence server coupled to the routing system. The routing system is adapted to receive phone calls and provide an indication to the presence server whether the phone calls

originate from registered users. The presence server maintains presence information for users, maintains watcher lists of the users who are being watched by specific other parties and transmits an indication to the other parties on the watcher lists that said users are present. Each user also maintains contact lists of other users. (See, e.g., Abstract and paragraphs 0018-0021 of Michael.)

The Examiner's Answer (e.g., page 20) again notes that Michael does not explicitly state that a watcher list is transmitted to the user in accordance with a request from the user. The Examiner's Answer states:

> [A]lthough Michael does not explicitly state that a watcher list is transmitted to the user in accordance with a request from the user, the fact that the server is creating, maintaining, and providing a buddy list to a user upon request, strongly points to the capability of the server which already creates and maintains a watcher list, to provide that watcher list to users upon request.

However, Appellants re-assert that Michael does not disclose that a buddy list is created, and transmitted from the presence server to the user upon request as is purported by the Examiner. Specifically, in response to Appellants prior remarks, the Examiner (page 19 of the Examiner's Answer) suggests that "while Michael discloses that the user maintains its buddy list, it is clear from Michael's disclosure, paragraph [0002], and traditional presence systems, that this made possible by a presence server providing the buddy list and corresponding services to the user upon request." Appellants dispute these statements by the Examiner as being unsupported. Appellants submit that it is not "clear" from Michael's disclosure that a buddy list is provided to a user upon the user's request. Appellants reproduce below Michael's paragraph [0002] that is cited by the Examiner:

[0002]   Modern messaging systems, such as those based on the Session Initiation Protocol (SIP), provide presence capabilities, particularly in association with Instant Messaging systems. In presence server systems, a user typically maintains a buddy list or contact list of persons for whom presence information is desired. The presence server system in turn maintains one or more watcher lists of those who are watching a particular user and to whom that user's presence information is sent. When a user A logs in, a presence server identifies the logged in user as present and transmits the information to users on the watcher list of user A. The active users can then exchange instant messages with user A, and the like.

As noted above, this paragraph [0002] is cited by the Examiner as disclosing "a presence server providing the buddy list and corresponding services to the user upon request." However, the paragraph does not disclose the providing of a buddy list from the presence server to a user upon the user's request. Rather, it specifically discloses that "a user typically maintains a buddy list or contact list of person for whom presence information is desired." Further, then, in connection with a watcher list, the paragraph specifically states that the presence server maintains one or more watcher lists and "When a user A logs in, a presence server identifies the logged in user as present and *transmits the information to users on the watcher list of user A*." (emphasis added).

Michael does not disclose either the transmission of a buddy list to a user, nor does Michael disclose the transmission of a watcher list to a user upon the user's request. What Michael does disclose is that a user maintains a buddy list and a presence server maintains a watcher list and transmits information to users on the watcher list about the user A, not that the watcher list itself is transmitted to user A.   Appellants note again that in paragraphs

[0018] and [0019], Michael discloses that each user maintains a contact list and the presence server unit maintains presence information for each of the users. Michael's server may pass presence information of one user to another user, but Michael does not disclose transmitting a buddy list, nor a watcher list, to a user at the request of the user.

Accordingly, Appellants submit that the Examiner's analysis concerning the implied transmission of a buddy list in Michael as being "support" for the implied transmission of a watcher list to a user, in response to the user's request, in Michael is flawed for the reasons as set forth herein. Appellants further discuss in detail below Appellants' arguments and traversals.

Specifically, Appellants again note that the Examiner states (page 20 of the Examiner's Answer): "As stated in examiner's rejection provided herein, although Michael does not explicitly state that a watcher list is transmitted to the user in accordance with a request from the user, the fact that the server is creating, maintaining, and providing a buddy list to a user upon request, strongly points to the capability of the server, which already creates and maintains a watcher list, to provide that watcher list to users upon request." However, this statement is fundamentally flawed, since by the Examiner's own citation to paragraph [0002] of Michael, it is apparent that Michael's server does not provide that a server creates, maintains or provides buddy list to a user upon request. Instead, paragraph [0002] of Michael merely discloses that a user maintains a buddy list. Nothing in the Examiner's citation indicates that a buddy list is transmitted to the user upon the user's request. Since Michael does not disclose the transmission of a buddy list to a user upon the

user's request as noted above, the citation to this "disclosure" as support for the assertion that transmitting a watcher list is obvious based on the "disclosed" transmission of a buddy list is logically and analytically flawed.

Moreover, beyond even the above-noted flaw in the rationale used to suggest obviousness of transmission of the watcher list from a presence server to a user at the user's request according to Appellants' recited features, Appellants dispute, once again, the Examiner's supposed justification as the basis for his "obviousness" assertion. This justification is stated on page 20 of the Examiner's Answer as follows:

> For a user to specify particular watchers, it would be strongly beneficial, if not necessary, for the user to be provided with a list of watchers. Hence these features and capabilities are already present in the prior art and require no hindsight reasoning for improving Michael's system.

Appellants maintain that there is no analytical basis or support for what the Examiner has concluded is "necessary" or "strongly beneficial" other than using Appellants own teachings against him. Appellants submit that the Examiner's own statements indicate that the features and capabilities are not explicitly present in the prior art.

Appellants again point out that it is not "necessary" for a list of watchers to be transmitted to the user the user's request, since this is not done in either the systems of De Vries nor Michael. Appellants refer to the discussion in the Appeal Brief concerning the argument of inherency that is implied by the Examiner assertion of "necessity." That is, clearly, it is not *inherent* (i.e., necessary) that a user be provided with a list of watchers to specify particular authorized watchers, since, for example, Michael already describes

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operation of a system that does not disclose or require that a list of watchers be transmitted to a user, and instead discloses merely that a user may communicate information about authorized watchers to the presence server.

The remaining justification then, as set forth by the Examiner, is that of the recited features being "strongly beneficial." As assertion of strongly beneficial, however, is an inappropriate justification to reject Appellants' claims. The Examiner explicitly states that Michael does not disclose the above-noted features recited by Appellants, nor are these features disclosed in any other cited prior art reference. Appellants agree with the Examiner that Appellants' claims, indeed, recite beneficial features. However, Appellants should not, and cannot, be penalized by hindsight reasoning like that noted by the Examiner who appears to be attempting to improve Michael's system using only the features and justification that are identified and recited by Appellants.

On page 20 of the Examiner's Answer, the Examiner merely states that he has not applied "hindsight reasoning," but the Examiner has not provided any citation or specific support in the prior art disclosures for what the Examiner has suggested is "strongly beneficial." The Examiner's argument based on necessity (i.e. inherency) demonstrably fails as noted above, and Appellants maintain that simply stating that Appellants claimed features would be "strongly beneficial" as a basis to modify the prior art cannot be reasonably sustained as justification for rejecting Appellants claims directed to those "strongly beneficial" features.

Furthermore, Appellants again submit that the action of transmitting a watcher list to a user upon request that is suggested in the Examiner's Answer as being "strongly" motivated in Michael is, in contrast, not consistent with the described operations of the system that are disclosed by Michael. Michael explicitly discusses the use of the presence server to maintain presence information of users and "watcher lists 1151 of those parties who are being watched by specific other parties." Michael discloses that the watcher list is provided on the presence server 1104 and that it is the presence server 1104 that performs a "check of authorization information" prior to distributing a presence information about a user. Nothing in Michael indicates that a user may request a watcher list of all the other users that may be watching the state of that user. At best, Michael provides at the end of paragraph [0021] that:

> It is noted that in certain embodiments, the users can specify which watchers are authorized to receive their presence information. Thus, a check of authorization information may occur prior such to [sic] distribution of a presence update.

Thus, according to Michael, a user may submit authorization information to the presence server about watchers which the presence server may then check before distributing a user's presence information to a requesting watcher. However, such disclosure does not provide that at a user request, a list of other users that are watching the state of user is transmitted to the user in the manner as recited by Appellants.

Appellants particularly note that an advantage provided by the presently-claimed invention is that, at any time, the user can request, and receive, a list of other users that are watching the state of the user. For example, in this manner, the user can decide, at that particular time, if any of those other users on the list should not be authorized to see the user's current state. That is, the user, having the list of watchers of the presence of the user

that has been transmitted to the user at the user's request, may then determine whether one or more of those watchers should not be authorized. In contrast, nothing in Michael's system provides for such operation, since, as noted above, Michael is silent as to any disclosure of transmitting a watcher list to a user at the user's request.

Since the Examiner states that Michael does not explicitly disclose the features recited by Appellants, and the reasoning used by the Examiner to then conclude "obviousness" from Michael of Appellants' recited features is flawed and not supported by any provided therefor, a rejection based on the Examiner's reasoning cannot be reasonably sustained. Accordingly, Appellants respectfully submit that the rejection of Appellants' claims over De Vries and Michael should be reversed by the Board.

Appellants note that the Examiner refers, at times, to capability of the server disclosed in Michael in analyzing the rejections of Appellants' claims. Appellants have disputed above the underlying analytical basis of the Examiner's arguments; however, Appellants also specifically assert that the arguments of capability of a server do not apply, regardless of the Examiner's underlying analytical basis, to Appellants' claims concerning a method of allowing client apparatuses in a presence display to display the states of other users, as specifically recited in claims 23-35 and 38-43. Accordingly, in addition to the arguments set forth above, Appellants respectfully submit that a prima facie case for rejecting method claims 23-35 and 38-43 has not been adequately set forth by the Examiner.
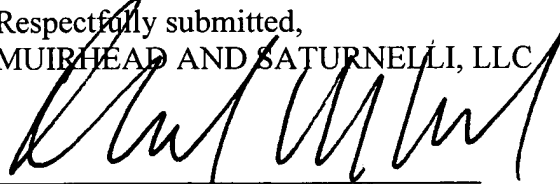
Additionally, Appellants reassert, as noted in the Appeal Brief, that the other cited references of Yoakum and Mora, as used in the rejections of claims 8, 17, 22, 25 and 26 and claims 15, 20 and 31, do not overcome the above-noted deficiencies of De Vries and Michael with respect to Appellants' present claims. Accordingly, for the reasons noted above and discussed in the previously-submitted Appeal Brief, it is requested that the Board reverse all the Examiner's rejections under 35 U.S.C. 103(a).

CONCLUSION

In view of the above, and the arguments previously submitted in Appellants' Appeal Brief, it is respectfully requested that the Board reverse all of the Examiner's rejections under 35 U.S.C. 103.

Respectfully submitted,
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